

Application No. 10/721,358

Docket No.: 1005/0136PUS1

REMARKS

Favorable reconsideration and allowance of the subject application are respectfully requested. Claims 1-9 and 22-29 are pending in this application.

The Office Action dated March 17, 2009, has been received and carefully reviewed. In that Office Action, objections were raised regarding the claim numbering and the drawings and a restriction requirement was made. In addition, claims 1-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa in view of Snider. Each of these issues is addressed below, and reconsideration and allowance of claims 1-9 and 22-29 is respectfully requested in view of the following remarks.

CLAIM NUMBERING

The claim set submitted with the previous amendment erroneously included a new claim 21 when claim 21 was already pending in the application. By the above amendment, Applicant has clearly identified claim 21 as "cancelled." The claims that were improperly numbered 21-28 in the previous reply have been renumbered 22-29, and their dependencies have been changed where necessary to reflect this renumbering. The amendment merely cancels claim 21 and places the remaining claims in the form they should have been in when the last amendment was filed. The entry of this amendment will place the application in better form for appeal, and the entry thereof is respectfully requested.

DRAWINGS

The drawings were objected to for failing to show an optical light guide and rotor

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formed as a single piece. Submitted herewith is a new Figure 3 which shows this feature. The withdrawal of the objection to the drawings is therefore respectfully requested.

SPECIFICATION

By the above amendment, the specification has been amended to refer to newly submitted Figure 3. The entry of this amendment is respectfully requested.

RESTRICTION REQUIREMENT

The Office Action includes a restriction requirement in connection with claims 22-29. The basis for this requirement is that the new claims include limitations that are different than the limitations of claims 1-9.

It is respectfully submitted that the presence of different limitations in two claims is not a basis for requiring restriction. Instead, the grounds for requiring restriction are set forth in MPEP 803, 806 and 808. The Office Action does not show that the inventions of claims 22-29 are independent and distinct from the inventions of claims 1-9 and does not provide any facts or arguments to show that searching these claims would present a serious burden as required by MPEP 808. Indeed, many of the "new limitations" are merely explicit statements of features that were present in the original claims. Explicitly stating, for example, that a previously claimed rotary knob has an "axis of rotation" does not make the invention defined by the new claim independent and distinct. The withdrawal of the restriction requirement and examination of claims 22-29 is therefore respectfully requested.

If this restriction requirement is not withdrawn, it is respectfully requested that the

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examiner satisfy the requirements of MPEP 803, 806 and 808 and show why the inventions of claims 22-29 are independent and distinct from the inventions of claims 1-9 and why searching these claims would constitute a serious burden on the examiner.

WITHDRAWAL OF PREVIOUS OBJECTIONS / REJECTIONS

The sole basis for rejecting claims 1-9 is that they are stated to be unpatentable over Hasegawa in view of Snider. Numerous claim objections and rejections raised in previous Office Actions are not repeated in the present Office Action. It is therefore assumed that all previous objections and rejections have been withdrawn based on Applicant's previously presented arguments and/or amendments. If this is incorrect, it is respectfully requested that the examiner provide clarification in a future communication.

CLAIM REJECTIONS

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa in view of Snider. This rejection is respectfully traversed.

Claim 1 recites a control element that includes, inter alia, a combined scale and corona illumination, an optical light guide formed from a single piece that includes two parts, a light rotor that extends towards the optical light guide, and a light source located below the light rotor. Claim 1 further recites that the optical light guide and the light rotor are formed as a single piece. The Office Action acknowledges that Hasegawa does not show a light guide and light rotor formed of a single piece. However, it is asserted that Snider shows a light guide and light rotor formed of a single piece and that it would have been obvious to modify Hasegawa based on Snider to make Hasegawa's elements 4 and

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6 unitary.

As an initial matter, it is noted that Snider shows a knob having a transparent rotor or shaft. It is not clear that Snider provides any suggestion of a unitary light rotor and light guide as claimed. Applicant reserves the right to argue this difference further if necessary. However, whether or not Snider is relied upon, it is respectfully submitted that making Hasegawa's light guide and light rotor as a single piece would prevent Hasegawa's rotor from rotating. This modification would thus render Hasegawa unsatisfactory for its intended purpose, and such modifications are never obvious. MPEP 2143.01. Thus, even if Snider suggests the modification proposed by the examiner, the modification is not an obvious modification and does not support a prima facie case of obviousness in connection with claim 1.

As can be seen from Figure 2 of Hasegawa, light guide 6 is not symmetric. The portion of light guide 6 beneath shaft 21 (as viewed in the drawing) is wider than the portion of the light guide above the shaft 21. If Hasegawa's elements 4 and 6 are made unitary, it will not be possible to rotate outer knob 2. This modification would either change the principle of operation of Hasegawa by turning his coaxial dial knob into a single knob and/or render Hasegawa unsatisfactory for its intended purpose by preventing the outer knob from rotating. Furthermore, any effort to change the structure of Hasegawa to allow light guide 6 to rotate would disadvantageously require that a large space surrounding shaft 21 be opened up to allow for rotational movement of the light guide 6. Increasing the room required for the operation of Hasegawa's knob and making the device less compact would appear to make Hasegawa's device less useful, and one skilled in the relevant arts would have no reason for making such a modification to Hasegawa. For at least these

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reasons, it is respectfully submitted that the modification to Hasegawa proposed by the examiner is not obvious. Claim 1 is submitted to be allowable over Hasegawa in view of Snider, and the withdrawal of the rejection of claim 1 is respectfully requested.

Claims 2-9 depend from claim 1 and are submitted to be allowable for at least the same reasons as claim 1.

Claims 22-29 are submitted to be allowable for at least the reasons provided in the previous Amendment.

CONCLUSION

Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Martin R. Geissler, Applicants' Attorney at 1.703.621.7140 so that such issues may be resolved as expeditiously as possible.


For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 50-3828 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,



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